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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/374,202 | 08/12/1999 | MARK A. BRENNER | ODS-1.CONT.4 | 3457 |

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| EXAMINER |
|---|
| ONEILL, MICHAEL W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3713 | |

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/374,202 | Applicant(s) BRENNER ET AL. | |
|---|---|---|---|
| | Examiner Michael O'Neill | Art Unit 3713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *28 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-105* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-105* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 August 1999* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *12,14*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of screens having wagering related content on a monitor connected to the user terminal and advertising information on at least one of the plurality of screens, addition to like limitations found in the other independent claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 through 105 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is now unclear where in the instant application has the support for the claims, particularly the amended language. Applicant did not bother to provide guidance with respect to page, line number, drawing and reference label as to what structures constitute the claimed invention. Applicant needs to provide such guidance. If there is no basis for the amended language, then the amended language is deemed new matter and must be removed.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional

rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 through 105 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 115 of copending Application No. 09/373,120. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 through 4, 10 through 14, 22 through 36, 65 through 82, and 94 through 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Algie, U.S. Patent No. 5,564,977 in view of Ueno, U.S. Patent No. 5,746,657.

Algie discloses the broadly claimed invention except the reference lacks clearly disclosing a place to make wagers; although the reference discloses a keyboard connected to the system. In analogous device, Ueno discloses a place to make wagers. It would have been obvious to apply the teachings of Ueno to the disclosed system of Algie in order to permit bettors to make wagers on the information supplied by Algie's system.

Claims 5 through 9, 15 through 21, 37 through 64, 83 through 93 and 101 through 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Algie and Ueno as applied to claims above, and further in view of Handelman, U.S. Patent No. 5,539,450.

Although Algie and Ueno disclose advertising, they lack clearly disclosing the ability to permit players to purchase merchandise and to have accounts for betting and shopping. In an analogous device, Handelman teachings such features in a system that permits gaming and shopping among other things. Therefore, it would have been obvious to one of ordinary skill in the art to apply the teachings found in Handleman to the

system of Algie and Ueno, in order to capitalize on the "spur of the moment" want of players seeing the products for sale.

***Response to Arguments***

Applicant's arguments filed 2-28-02 have been fully considered but they are not persuasive.

First, the amended language does not provide any patentably different between the prior art of record and the claimed invention. Monitors, displays, screens, be they big or small or in singular or found in a plurality are notoriously well known to those of ordinary skill in the art.

Second, with respect to the Ueno, reference: a) places to wager is a universal fact, if the Applicant has any case law to support Applicant's position, then the Applicant should provide it to the Examiner for consideration and b) where the Examiner mentions Ueno with advertising is in a 103 rejection that incorporates the discussion of the previous paragraphs above, see the Office action and read it carefully. Therefore, what the Examiner states is the combination of Algie and Ueno demonstrate advertising as well known, not Ueno by itself demonstrates advertising. The advertising disclosure is found within the Algie reference.

Third, the Examiner respectfully disagrees with the Applicant's arguments addressing the prior art. The Applicant

attacks the references and the skill of those skill in the art individually rather than as a whole. Therefore, because the rejection is based on obviousness of the claimed invention, attacking the references individually and not taking into account one of ordinary skill in the art is not a persuasive argument.

Fourth, the Examiner respectfully disagrees with the Applicant's non-analogous art argument. Handelmann is analogous to the nature of the problem to be solved and within the Applicant's field of endeavor.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Thursday 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MON
April 23, 2002

MICHAEL O'NEILL
PRIMARY EXAMINER